

**UNITED STATES DEPARTMENT OF COMMERCE****Patent and Trademark Office**Address: COMMISSIONER OF PATENTS AND TRADEMARKS
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/301, 749 04/29/99 POWELL

K 104.012

EXAMINER

TM02/0925

ATTEN: JEROME D JACKSON
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ART UNIT

PAPER NUMBER

2165

DATE MAILED:

09/25/01 16

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary	Application No. 09/301,749	Applicant(s) Powell et al.
	Examiner Cuong H. Nguyen	Art Unit 2165

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on Jul 5, 2001
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 19-24, 26, 28-40, and 42-46 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 19-24, 26, 28-40, and 42-46 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) The proposed drawing correction filed on _____ is: a) approved b) disapproved.
- 12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a) All b) Some* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

- 14) Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) Notice of References Cited (PTO-892)
- 16) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
- 18) Interview Summary (PTO-413) Paper No(s). _____
- 19) Notice of Informal Patent Application (PTO-152)
- 20) Other: _____

DETAILED ACTION

1. This Office Action is the answer to the communication received on 7/05/2001 (the Amendment under 37 CFR 1.121).
2. Claims **19-24, 26, 28-40, 42-46** are pending in this application.

Response to Amendment

3. Applicants' arguments received on 7/05/2001 have been fully considered but they are not persuasive with previous rationale for rejections; only rejections on non-statutory subject matter are withdrawn.

Accordingly, **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

4. The following are US Patent case rulings applying in this examination.

A. In re Hiniker Co., 47 USPQ2d 1523, 1529 (Fed. Cir. 1998), the court ruled: "The name of the game is the claim." (in the argument on page 4, para.6, a paragraph of the specification is cited; accordingly to in re Hiniker Co., this is improper). In addition, the applicants argue that "content of applicant's specification is not used as evidence that the scope of the claims is inconsistent with the subject matter which applicants regard as their invention..."; the examiner submits that the use of at least a computer is obviously required for this invention, without claiming it, the claim is incomplete and it can be rejected on 35 USC 112 2nd para.

B. On page 5, para.2, the language of claim 29 is examined, and the examiner cited a distinguishing fact of "a memory is always a passive device" until it is execute/command by another source. If the applicants understand the term "signal" to be a broad one, encompassing a function, or an embodiment of a message; the examiner would interpret it as prior Office Action.

C. Although operational characteristics of a system may be apparent from the specification, we will not read such characteristics into the claims when they cannot be clearly connected to the structure recited in the claims. See In re Self, 671 F.2d 1344, 1348, 213 USPQ 1, 5 (CCPA 1982). When given their broadest reasonable interpretation, the claims on examination sweep in the prior art, and the prior art would have directed an artisan of ordinary skill to make any

combination cited by the examiner. ("The US is strictly an examination country and the main purpose of the examination, to which every application is subjected, is to try to make sure that what each claim defines is patentable. To coin a phrase, the name of the game is the claim").

D. Claims' language could be read-on by cited references and no reasonable distinguishing limitation has been made in claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ 2d 1057 (Fed. Cir. 1993).

E. It is reasonable that various modifications of prior art would be apparent to those skilled in the art at the time of invention without departing from the scope and spirit of these inventions. Although cited inventions may have been described in connection with specific preferred embodiments, it should be understood that their limitations as disclosed should not be unduly limited to such specific embodiments.

F. In re Scheckler, 168 USPQ 716 (CCPA 1971), the court ruled:

It is not necessary that a reference actually suggest changes or possible improvements which applicant made. The PTO can show that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the cited references.

G. In re Bozek, 163 USPQ 545 (CCPA 1969), the court ruled:

"Reference disclosure must be evaluated for all that it fairly suggests and not only for what is indicated as preferred."

H. In re Jacoby, 135 USPQ 317 (CCPA 1962), the court ruled:

"Problem cannot be approached on basis that workers in the art would know only what they could read in references; those skilled in radiator art must be presumed to know something about radiators apart from what references disclose", "it is immaterial that reference does not disclose specific function set forth in applicants' specification, since this is merely an additional attribute possessed by reference structure which would be obvious to one skilled in the art in a use which one skilled in the art, following teachings of prior art, might make of it"

I. Merck & Co. Inc. v. Biocraft Laboratories Inc., 10 USPQ2d 1843 (CA FC 1989), the court ruled:

A reference may be relied upon for all that it would have reasonably suggested to one having ordinary skill in the art, including non-preferred embodiments.

K. In re Heck, 216 USPQ 1038 (Fed. Cir. 1983), the court ruled:

"The use of patents as references is not limited to what the patentees describe as their own inventions or to the problems with which they are concerned. They are part of the literature of the art, relevant for all they contain."

L. In re Keller, Terry, and Davies, 208 USPQ 871 (CCPA 1981), the court ruled:

"It is not necessary that device shown in one reference can be physically inserted into device shown in other reference

to justify combining their teachings in support of rejection."

"Test of obviousness is not whether features of secondary reference may be bodily incorporated into primary reference's structure, nor whether claimed invention is expressly suggested in any one or all of references; rather, test is what combined teachings of references would have suggested to those of ordinary skill in art."

M. Ex parte Rubin, 5 USPQ2d 1461 (BdPatApp&Int 1987), the court ruled: Knowledge in the art may have advanced such that results considered incredible are no longer per se incredible.

N. In re Conrad, 169 USPQ 170 (CCPA 1971), the court ruled:

The test for obviousness under 35 U.S.C. 103 is not the express suggestion of the claimed invention in any or all of the references but what the references taken collectively would suggest.

5. The following rejections are based on the examiner's broadest reasonable interpretation of the claims, *In re Pearson*, 181 USPQ 641 (CCPA 1974).

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with claims particularly pointing out and distinctly claiming the subject matter which the applicants regard as their invention.

A. Claim 19, 29, 43 are rejected under 35 U.S.C. 112, second paragraph, as failing to set forth the subject matter which applicants regard as their invention. Evidence that claims 29, 43 fail to correspond in scope with that which applicant(s) regard as the invention can be found in Paper No. 1 filed 4/29/1999. In that paper, applicant has stated that the invention is about "a computer system configuration and method for processing discount information in a retail store.", and this statement indicates that the invention is different from what is defined in the claim(s) because there is no such subject matter's limitations in the bodies of those claims (a limitation of the claim only counts if it is disclosed in the body of a claim). These claims would be incomplete if this baseline is left-out; therefore, they are still proper with 35 USC 112, 2nd para. Rejections.

B. A limitation of claim 29 said "to correlate the second signals with third signals from the card memory..." the examiner submits that such card memory is a passive device, it does not have an "active" signal (as called "third signal"); therefore, the claim is not clear in this sense. The term for "third signal" is not correctly used herein.

7. Claim 43 is rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to

particularly point out and distinctly claim the subject matter which applicant regards as the invention.

This claim recites limitations of "...executing ... a second program ... to correlate second signals with third signals ..." there are insufficient antecedent basis for this limitation in claim (because said "third signal" is undefined, and therefore, indefinite).

8. Claims **19, 29, 35, 43** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention (the use of a computer system in this application). These claims would be incomplete if missing this element and they are rejected on 35 USC 112, 2nd para.

Viewing as a whole, those independent claims must include a computer system (or a computer-implemented method) for operating claimed means/steps (see at least the specification for using of a computer system in this application); without claiming this structure as essential "baseline" of this application, the claim is incomplete.

9. Claims **20-24, 26, 28, 30-34, 36-40, 42, 44-46** are rejected under 35 U.S.C. 112, 2nd para. because they are dependent on their parent claims. In general, independent claims, have to be amended in order to improve claims' format to comply with US Patent laws.

- A. In a broad reasonable interpretation, all the claims direct to a way of communicating between a computer and a scanning device. Therein, delivered messages are responded correspondingly to the predetermined content from computer devices.
- B. The examiner recognized that references cannot be arbitrarily combined and that there must be some reason why one skilled in the art would be motivated to make the proposed combination of primary and secondary references. *In re Nomiya*, 184 USPQ 607 (CCPA 1975).
- C. However, there is no requirement that a motivation to make the modification be expressly articulated. The test for combining references is what the combination of disclosures taken as a whole would suggest to one of ordinary skill in the art. *In re Simon*, 174 USPQ 114 (CCPA 1972); *In re McLaughlin*, 170 USPQ 209 (CCPA 1971).

Conclusion

- 10. All pending claims are rejected.
- 11. These references are considered pertinent to applicants' disclosure.
 - Sugiyama et al., (US Pat.5,670,716 - filing date is 10/04/1995, patent date: 9/02/1999; US Class. 705/26),

about a home terminal and shopping system (see the summary of the invention).

- Valencia et al., (US Pat.5,380,991 - filing date is 11/16/1993, patent date: 1/10/1995; US Class. 705/14), about a paperless coupon redemption system and method thereof (see the summary of the invention).

- Mueller et al., (US Pat. 5,353,219 - filing date is 6/10/1993, patent date: 10/04/1994; US Class. 705/16), about a suggestive selling in a customer self-ordering system (see the summary of the invention).

- O'Hagan et al. (US Pat. 5,821,513), disclose a shopping cart mounted portable data collection device - filing date is 11/05/1996) (see the summary of the invention).

12. Notes:

Claim 43 is the most complex/sophisticated claim; it covers all limitations of independent claims (19, 29, and 35) although claims' language is different). Therefore, the rationale for rejection of claim 43 are obviously applied for all independent claims.

The examiner submits that the reasons for rejection are obvious (v.s. cited prior arts) with **claims' language**. In re Mraz, 59 CCPA, F.2d, 173 USPQ 25, 28 (1972), it says: "Claims which are broad enough to read on obvious subject matter are unpatentable even though they also read on nonobvious subject matter".

A. *In re Van Geuns*, 26 USPQ2d 1057 (CA FC 1993), the court rules: Although claims are interpreted in light of the specification, limitations from the specification are not read into the claims.

B. *In re Prater*, 162 USPQ 541 (CCPA 1969), the court rules: During patent examination, the pending claims must be given the broadest reasonable interpretation consistent with the specification. Reading a claim in light of the specification, to thereby interpret limitations explicitly recited in the claim, is quite different from reading limitations of the specification into a claim, to thereby narrow the scope of the claim by implicitly adding disclosed limitations which have no express basis in the claim.

C. *Ex parte Pfeiffer*, 135 USPQ 31 (BdPatApp&Int 1961), the court rules: "As to the rejection of the claims on the prior art references, we do not agree with the appellant that such structural limitations as are not disclosed by the references should be given patentable weight. This argument is applicable to claims drawn to structure and not claims drawn to a method. To be entitled to such weight in method claims, the recited structural limitations therein must affect the method in a manipulative sense and not to amount to the mere claiming of a use of a particular structure, which, in our opinion, is the case here."

Note About Treatment of Combined References

D. *In re Keller, Terry, and Davies*, 208 USPQ 871 (CCPA 1981), the court rules: "One cannot show nonobviousness by attacking references individually where rejections are based on combinations of references."

E. *In re Merck & Co., Inc.*, 231 USPQ 375 (CA FC 1986), the court rules: "Non-obviousness cannot be established by attacking references individually where the rejection is based upon the teachings of a combination of references."

F. *In re Nievelt*, 179 USPQ 224 (CCPA 1973), the court rules: "Combining teachings of references does not involve an ability to combine their specific structures."

G. *In re Bozek*, 163 USPQ 545 (CCPA 1969), the court rules: "Test for obviousness is not whether features of one reference may be bodily incorporated into the other to produce claimed subject matter but simply what the combination of references makes obvious to one of ordinary skill in pertinent art."

H. *In re Keller, Terry, and Davies*, 208 USPQ 871 (CCPA 1981), the court rules: "It is not necessary that device shown in one reference can be physically inserted into device shown in other reference to justify combining their teachings in support of rejection."

I. "Test of obviousness is not whether features of secondary reference may be bodily incorporated into primary reference's structure, nor whether claimed invention is expressly suggested in any one or all of references; rather, test is what combined teachings of references would have suggested to those of ordinary skill in art."

J. **In re Hiniker Co.**, 47 USPQ2d 1523, 1529 (Fed. Cir. 1998)), the court rules: "**The name of the game is the claim.**"

K. "Although operational characteristics of an apparatus may be apparent from the specification, we will not read such characteristics into the claims when they cannot be fairly connected to the structure recited in the claims". See **In re Self**, 671 F.2d 1344, 1348, 213 USPQ 1, 5 (CCPA 1982). When given their broadest reasonable interpretation, the claims on examination sweep in the prior art, and the prior art would have directed an artisan of ordinary skill to make the combination cited by the examiner. ... discloses a structure that meets the claim limitations. See **Giles Sutherland Rich**, Extend of Protection and Interpretation of Claims -- American Perspectives, 21 Int'l Rev. Indus. Prop. & Copyright L. 497, 499 (1990) ("The US is strictly an examination country and the main purpose of the examination, to which every application is subjected, is to try to make sure that

what each claim defines is patentable. To coin a phrase, the name of the game is the claim.")

L. The test for combining references is not what the individual references themselves suggest but rather what the combination of the disclosures taken as a whole would suggest to one of ordinary skill in the art. In re **Kuderna**, 165 USPQ 575 (CCPA 1970).

M. *Ex parte Rubin*, 5 USPQ2d 1461 (BdPatApp&Int 1987)
Knowledge in the art may have advanced such that
results considered incredible are no longer per se
incredible.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner Cuong H. Nguyen, whose telephone number is (703)305-4553. The examiner can be reached on Mon.-Fri. from 7:00AM-3:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ms. Wynn Coggins, can be reached on (703)308-1344.

Any response to this action should be mailed to:

Amendments

Commissioner of Patents and Trademarks

c/o Technology Center 2100

Washington, D.C. 20231

or faxed to: (703) 308-9051, (for formal
communications intended for entry)

09/301,749
Art Unit 2165

Or: (703) 305-0040 (for informal or draft communications, please label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II,
2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

Cuong Nguyen
Patent Examiner
Sept. 18, 2001